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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91212931
Party	Plaintiff McDonald's Corporation
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Date	11/27/2013
Attachments	Motion to Strike Affirmative Defenses.pdf(73237 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

McDONALD'S CORPORATION, Opposer, GREGG DONNENFELD, Applicant.	Mark: EGG WHITE DELIGHT **Opposition No. 91212931** Serial No. 85/877,499

OPPOSER'S MOTION TO STRIKE APPLICANT'S AFFIRMATIVE DEFENSES

Opposer McDonald's Corporation, pursuant to Federal Rule of Civil Procedure 12(f) and TBMP §506, hereby moves this Board for an order striking Applicant's five affirmative defenses set forth in his Answer, each of which is legally deficient, and serves only to confuse the issues in the case and unnecessarily increase the expense of discovery. In support of this motion, Opposer states as follows:

1. On October 11, 2013, Opposer initiated this proceeding against Applicant, opposing Applicant's U.S. App. No. 85/877,499 for the mark EGG WHITE DELIGHT for use in connection with breakfast sandwiches on the grounds, including, among others, that the mark that Applicant seeks to register is confusingly similar to Opposer's EGG WHITE DELIGHT McMUFFIN trademark.

2. On November 11, 2013, Applicant filed his Answer to the Notice of Opposition, containing five purported affirmative defenses. As described more fully below, however, each of the affirmative defenses is fatally deficient. Indeed, each is either: (i) a "bare bones," conclusory statement that fails to comply with Rule 8 of the Federal Rules of Civil Procedure; (ii) merely a restatement of Applicant's denial of Opposer's allegations; or (iii) legally untenable.

3. An affirmative defense "directly or implicitly concedes the basic position of the opposing party but […] asserts that notwithstanding that concession the opponent is not entitled to prevail because he is precluded for some other reason." *Choice Hotels Int'l, Inc. v. Madison Three, Inc.*, 83 F. Supp. 2d 602, 602 (D. Md. 2000). In other words, an affirmative defense must raise matters that are distinct from, and not merely denials of, the elements of the opposing party's claims. *Emergency One, Inc. v. Am. Fire Eagle Engine, Co.*, 332 F.3d 264, 272 (4th Cir. 2003) (an affirmative defense adds new matter which, assuming the complaint to be true, states a defense to it); *Order of Sons of Italy in Am. v. Profumi Fratelli Nostra AG*, 36 U.S.P.Q.2d 1221, 1223 (TTAB 1995) (noting that "applicant's second defense is nothing more than a restatement of that denial" and striking as redundant).

4. In addition, Rule 8 of the Federal Rules of Civil Procedure requires that affirmative defenses must do more that merely assert "bare bones, conclusory allegations" that fail to put Opposer on notice of the underlying bases for the purported defenses. *See Linc. Fin. Corp. v. Onwuteaka*, No. 95C4928, 1995 WL 708575, at *3 (N.D. Ill. Nov. 30, 1995) (holding that if an affirmative defense contains only a conclusory statement, it must be stricken); *Shah v. Colleto, Inc.*, No. DKC 2004-4059, 2005 U.S. Dist. LEXIS 19938, at *12 (D. Md. Sept. 12, 2005) (noting that the court "need not…accept unsupported legal allegations, legal conclusions couched as factual allegations or conclusory factual allegations devoid of any reference to actual events" under pleading standard of Rule 8).

5. Motions to strike should be granted when they "simplify the pleadings and save time and expense by excising from [the pleading] any redundant, immaterial, impertinent, or scandalous matter which will not have any possible bearing on the outcome of the litigation." *Garlanger v. Verbeke*, 223 F. Supp. 2d 596, 609 (D.N.J. 2002). *See also Heller Fin., Inc. v. Midwhey Powder Co.*, 883 F.2d 1286, 1294 (7th Cir. 1989) ("where … motions to strike remove

unnecessary clutter from the case, they serve to expedite, not delay"). Furthermore, where an affirmative defense that "might confuse the issues in the case and would not, under the facts alleged, constitute a valid defense to the action, [the affirmative defense] can and should be deleted." *Waste Mgmt. Holdings, Inc. v. Gilmore*, 252 F.3d 316, 347 (4th Cir. 2001). That is the case here.

All of Applicant's Affirmative Defenses Fail to Allege Sufficient Facts

6. As a threshold matter, each of Applicant's affirmative defenses is factually insufficient. Indeed, each is precisely the sort of "bare bones, conclusory" statement that is not permitted. None contains a single factual allegation of the nature required by Rule 8. For example, Applicant's third affirmative defense merely asserts that "Opposer's status […] does not permit or entitle Opposer to acquire national trademark rights in the absence of use[.]" Answer at ¶16. Similarly, Applicant's fourth affirmative defense alleges, without any factual support, that "Opposer had abandoned such rights [in EGG WHITE DELIGHT McMUFFIN or in Applicant's mark] prior to the date of Applicant's intent-to-use filing." Answer at ¶17. Each of Applicant's affirmative defenses similarly fails to allege any specific facts. *See* Answer at ¶¶14-15 and 18. These bare legal conclusions are insufficient, as they fail to give Opposer notice of any conduct on which Applicant bases the defenses or to comply with the requirements of Rule 8 of the Federal Rules of Civil Procedure and, therefore, must be stricken. *See Linc. Fin. Corp.*, 1995 WL 708575 at *3.

Applicant's First, Second and Third Affirmative Defenses are Mere Denials

7. Applicant's first, second, and third affirmative defenses are mere denials of Opposer's allegations and, therefore, must be stricken. In his first affirmative defense, Applicant alleges that "Applicant has priority of rights with respect to the EGG WHITE DELIGHT mark by virtue of having filed an intent-to-use trademark application prior to the date that Opposer

made any trademark filing for the mark." Answer at ¶14. This conclusory statement is merely a denial of Paragraphs 4-6 and 9 of the Notice of Opposition, which asserts that Opposer has prior rights in its EGG WHITES DELIGHT McMUFFIN mark. *See* Notice of Opposition at ¶¶4-6 and 9. The second affirmative defense further claims that Applicant has priority because "by virtue of having filed an intent-to-use trademark application prior to the date that Opposer made common law trademark use" of the mark. Answer at ¶15. Again, however, this is yet another denial of Paragraphs 4-6 and 9 of the Notice of Opposition, which asserts that Opposer's first use of its EGG WHITE DELIGHT McMUFFIN mark predates Applicant's filing. *See* Notice of Opposition at ¶¶4-6 and 9. Similarly, as discussed above, Applicant's third affirmative defense is a bare legal conclusion that "Opposer [is not] exempt from the rules and laws that apply to the general public." Answer at ¶16. The remainder of the third affirmative defense seems to argue that Opposer has an "absence of use" of its mark, but this is merely a denial of Opposer's allegations of use, namely those set forth in Paragraphs 4-6 of the Notice of Opposition. Answer at ¶16; *see also*, Notice of Opposition at ¶¶4-6

8. Therefore, Applicant's first, second and third affirmative defenses merely deny the two critical elements of Opposer's allegations, namely that it has (1) established common law rights in its EGG WHITE DELIGHT McMUFFIN mark that (2) predate Applicant's filing date. *Embarcadero Technologies Inc. v. RStudio Inc.*, 105 U.S.P.Q.2d 1825, 1834 (TTAB 2013) (noting that "to the extent opposer wishes to rely on its common law rights, it must establish priority with respect to such rights."). Such defenses are, therefore, deficient because they do not allege additional matter that would defeat Opposer's claims, even if all the allegations in the Notice of Opposition are taken as true.

9. Moreover, because Applicant bears the burden of proving the elements of any affirmative defense, Applicant's re-pleading of his denials as affirmative defenses further

confuses and complicates the procedural and evidentiary burdens in this case, and could significantly confuse the finder of fact. *See, e.g., Bridgestone/Firestone Research Inc. v. Automobile Club de l'Ouest de la France,* 58 U.S.P.Q.2d 1460, 1462 (Fed. Cir. 2001) (party raising affirmative defense bears the burden of proof). Applicant already has denied Opposer's allegations. *See* Answer at ¶¶ 4-6, 9 and 11. His repetition of those denials as affirmative defenses is unnecessary and, therefore, there is no reason to permit such affirmative defenses to stand.

Applicant's Fourth and Fifth Affirmative Defenses are Legally Untenable

10. As a matter of law, Applicant cannot plead facts sufficient to support his fourth affirmative defense of abandonment. Answer at ¶17. To establish abandonment, Applicant must plead and then prove "the intentional relinquishment or abandonment of a known right." *Kontrick v. Ryan,* 540 U.S. 443, 458 n.13 (2004) (internal quotation omitted) (overruled in part on other grounds); *ITC Ltd. v. Punchgini Inc.*, 82 U.S.P.Q.2d 1414, 1420 (2d Cir. 2007) (abandonment occurs where an owner ceases to use a mark without an intent to resume use in the reasonably foreseeable future). As illustrated by both the procedural history of this action and facts pled therein, however, there are no facts that Applicant has pled, nor could plead, in support of this defense. Opposer began using its EGG WHITE DELIGHT McMUFFIN mark in June 2012. *See* Notice of Opp. at ¶4. Just nine months later, in March 2013, Opposer announced the national expansion of its EGG WHITE DELIGHT McMUFFIN breakfast sandwich. *See* Notice of Opp. at ¶5. Two days after Opposer's press release, Applicant filed the subject application based on his purported intent to use the mark in commerce. (*See* Trademark Electronic Search System (TESS) printout for the subject application, attached hereto as Exhibit A). Soon after the subject application published in the Official Gazette, on October 1, 2013, Opposer timely filed its Notice of Opposition in this proceeding on October 11, 2013. Under these already pled facts,

Opposer certainly cannot be found to have relinquished or abandoned any rights in its EGG WHITE DELIGHT McMUFFIN mark or otherwise in relation to this matter. Accordingly, Applicant's fourth affirmative defense should be stricken.

11. Similarly, Applicant's fifth affirmative defense is legally deficient. Specifically, Applicant alleges, in the alternative, that "if and to the extent Opposer acquired rights in the EGG WHITE DELIGHT mark in one or more limited geographic parts of the United States prior to the date of Applicant's intent-to-use filing, then Applicant's application should proceed to registration with respect to all other parts." Answer at ¶18. In essence, therefore, Applicant argues that his application should be registered as a concurrent use registration. Pursuant to Section 2(d) of the Trademark Act, an eligible applicant may request issuance of a registration based on rights acquired by concurrent use of its mark, either with the owner of a registration or application for a conflicting mark or with a common-law user of a conflicting mark. 15 U.S.C. §1052(d). An applicant is only eligible to request a concurrent use registration if it meets one or more of the following criteria: (1) the request is sought pursuant to a court order; (2) the owner of the senior mark consents to the grant of a concurrent use registration; or (3) the applicant's date of *first use in commerce* is before the filing date of any application to register the mark by the senior user. 15 U.S.C. §1052(d); see also, TMEP § 1207.04(c). Here, because Applicant has failed to use the mark in commerce to date, he meets none of these threshold requirements. Moreover, as a procedural matter, because Applicant has filed his application based on his purported intent to use the mark in commerce under 15 U.S.C. §1051(b), he may not amend to seek concurrent use registration until he has filed a specimen evidencing use of the mark in commerce. 37 C.F.R. §§2.73 and 37 C.F.R. §2.99(e) (The applicant has the burden of proving that it is entitled to a concurrent use registration.). As a matter of law, therefore, Applicant is not

entitled to a concurrent use registration. Accordingly, Applicant's fifth affirmative defense is legally deficient and should be stricken.

12. As a result of the foregoing deficiencies, if Applicant's defenses are allowed to stand, Opposer will be forced to serve discovery requests and dedicate deposition time, not only to discover the basis of Applicant's affirmative defenses, but also to prepare Opposer's responses to these defenses. Granting the present motion will, therefore, serve the interests of the parties and the Board by removing factually and legally untenable defenses as well as irrelevant and unnecessary issues from the proceeding and allow this case to move forward in an efficient and focused manner. *See Garlanger*, 223 F. Supp. 2d at 609.

WHEREFORE, McDonald's Corporation respectfully requests that the Board:

(1) enter an Order granting its Motion and striking each of Applicant's affirmative defenses; and

(2) grant McDonald's Corporation any such additional and further relief that the Board deems proper.

Date: November 27, 2013

Respectfully submitted,

By: /Michael G. Kelber/
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CERTIFICATE OF SERVICE

I hereby certify that I served a copy of the foregoing **OPPOSER'S MOTION TO STRIKE APPLICANT'S AFFIRMATIVE DEFENSES** upon:

Gregg Donnenfeld
6 Wren Drive
Roslyn, New York 11576-2722

by depositing said copy in a properly addressed envelope, First Class postage prepaid, and depositing same in the United States mail at Two North LaSalle Street, Chicago, Illinois, on the date noted below:

Date: November 27, 2013

By: /Jessica E. Cohen/
One of the Attorneys for Opposer,
McDonald's Corporation

EXHIBIT A

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EGG WHITE DELIGHT

Word Mark	EGG WHITE DELIGHT
Goods and Services	IC 030. US 046. G & S: Breakfast sandwiches
Standard Characters Claimed	
Mark Drawing Code	(4) STANDARD CHARACTER MARK
Serial Number	85877499
Filing Date	March 15, 2013
Current Basis	1B
Original Filing Basis	1B
Published for Opposition	October 1, 2013
Owner	(APPLICANT) Donnenfeld, Gregg INDIVIDUAL UNITED STATES 6 Wren Drive Roslyn NEW YORK 11576
Disclaimer	NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "EGG WHITE" APART FROM THE MARK AS SHOWN
Type of Mark	TRADEMARK
Register	PRINCIPAL
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